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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/540,843 03/31/00 GILCHREST

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021005 HM22/0703
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LEXINGTON MA 02421-4799

EXAMINER

DRABIK, C

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/540,843

Applicant(s)

GILCHREST ET AL.

Examiner

Christopher Drabik

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-32, 71-83, 85, 86, 88 and 89 drawn to methods of 1.) reducing photoaging, 2.) increasing melanin production, 3.) increasing DNA repair, 4.) inhibiting proliferation of epithelial cells, 5.) treating hyperproliferative diseases, 6.) increasing p53 activity and 7.) preventing DNA damage classifiable in class 536, subclass 23.1.
- II. Claims 39-44 drawn to a method of promoting apoptosis in epithelial cells classifiable in class 536, subclass 23.1.
- III. Claims 33-38 drawn to a method of promoting immunosuppression, classifiable in class 536, subclass 23.1.
- IV. Claims 45-50 and 84, drawn to a method of treating allergic inflammation, classifiable in class 536, subclass 23.1

Please note claims 51-70, 87 and 90-92 have non-overlapping relatedness to the claims of the groupings set forth above. Claims 51-70, 87 and 90-92 will be examined in as far as the subject matter pertains to the elected Group.

Groups I –IV are each drawn to distinct inventions. The inventions are distinct from each other because they involve different biological processes, are directed at achieving different ends and require different criteria for assessing enablement. For example, methods of promoting immunosuppression are directed at results which are clearly distinguishable from methods intended to increase melanin production. Further, although the subject matter can be commonly classified, each invention is drawn to considerably divergent biologic processes and the searches required for each invention would not significantly overlap. Hence, searching the claims in there entirety would pose an undue burden.

Applicants are also required to elect one of the following patently distinct species of backbone to which examination on the merits will be limited: phosphodiester, phosphorothioate, phosphorodithioate, phosphoramidate, methylphosphate. Examiner is using phsophodiester to mean exclusively a PO_4 linkage between nucleotides.


Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Drabik whose telephone number is 703-605-1156. The examiner can normally be reached on Monday-Friday from 9am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark, can be reached on 703-305-4051. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242.

Inquiries of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234. Questions regarding review of formality issues may be directed to Kim Davis, the patent analyst assisting in this application. She may be reached at 703-305-3015.


DEBORAH J. R. CLARK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600